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JAN 09 2006

**OFFICE OF PETITIONS**

In re Application of :  
Indu Isaacs :  
Application No. 09/750,022 : DECISION ON APPLICATION  
Filed: December 29, 2000 : FOR  
Atty Docket No. 016777/0454 : PATENT TERM ADJUSTMENT  
: :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. §154(b)," filed July 5, 2005. Applicant requests correction of the patent term adjustment from zero (0) days to four hundred ninety-four (494) days partly on the basis of the Office taking in excess of three years to issue the patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentee is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the

patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

However, for the reasons stated herein, the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance remains **zero (0)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 4, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. Applicant timely filed the instant application for patent term adjustment<sup>1</sup>. Applicant disputes the reduction of 160 days for applicant delay in responding to the non-final Office action mailed March 8, 2002. Applicant states that their response was filed on June 10, 2002, and thus, the reduction pursuant to § 1.704(b) should only be 2 days. Further, applicant asserts that given receipt of the response on June 10, 2002, a period of adjustment of 118 days should be entered for Office delay in not mailing an Office action in response until February 5, 2003. In support thereof, applicant submits a copy of their itemized and date-stamped return postcard, associated with the filing of the amendment.

Consideration of petitioner's evidence is unnecessary. A review of the application file confirms that the amendment was filed on June 10, 2002. The amendment is present in the application with a date of receipt in the Office of June 10, 2002 stamped thereon. A clean copy of the amendment, presumably at the examiner's request, was faxed to the Office on November 15, 2002. Under these circumstances, the date of receipt of the

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<sup>1</sup> Office records show that the Issue Fee payment was also received on July 5, 2005. A copy of the PTOL-85(b) was submitted on April 21, 2005 with a Statement on Substance of Interview, but no payment of Issue Fee appears to have accompanied it. Thus, the instant paper is considered timely filed.

response on June 10, 2002 should be properly used for purposes of calculating compliance with 37 CFR 1.704(b). The response was complete and proper, but was filed outside of the three-month period under § 1.704(b). Thus, the Office should have assessed applicant a delay of two (2) days, not one hundred sixty (160) days. Applicant failed to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the non-final Office action, but only by 2 days.

Applicant is also correct that a period of adjustment of 118 days should be entered for Office delay. The reply under § 1.111 was filed on June 10, 2002; however, the Office did not respond with the mailing of a non-final rejection until February 5, 2003, four months and 118 days later. See §§ 1.702(a) and 1.703(a)(2).

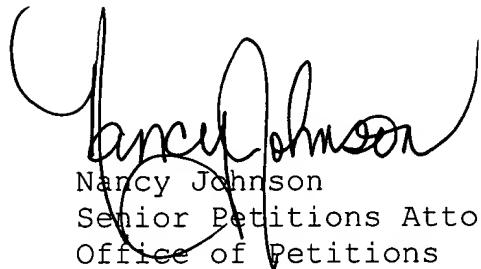
In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains zero (0) days (118 days of Office delay reduced by 158 (2 + 65 + 91) days of applicant delay).

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen